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OFFICE OF PETITIONS

In re Application of :
Halbmaier :
Application No. 09/884,450 : DECISION ON APPLICATION
Filed: June 18, 2001 : FOR
Atty Docket No. 2267.421US02 : PATENT TERM ADJUSTMENT
:

This is a decision on the "APPLICATION FOR PATENT TERM ADJUSTMENT INCLUDING REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN NOTICE OF ALLOWANCE (37 CFR § 1.705)," filed July 2, 2004. Applicant requests correction of the patent term adjustment from ninety-five (95) to one hundred sixty-seven (167) days based in part on the Office taking in excess of three years to issue the patent.

To the extent that the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b).

Patentee is given **TWO (2) MONTHS** from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Patentee may seek such consideration without payment

of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

As to the application for patent term adjustment, it is **GRANTED** to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is one hundred fifty-one (151) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On March 31, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment to date is 95 days. Applicant timely filed the instant application for patent term adjustment, along with payment of the Issue Fee. Applicant disputes both the reduction of 61 days for applicant delay in responding to the Notice to File Missing Parts of Application mailed August 14, 2001; and the reduction of 66 days for applicant delay in responding to the final rejection mailed September 16, 2003. Applicant states that their response to the Notice to File Missing Parts was received in the Office on January 2, 2002, and thus, the period of reduction associated therewith should be 49 days. Applicant states that the delay pursuant to § 1.704(b) should be 6 days for taking in excess of three months to respond to the advisory action mailed January 23, 2004, not 66 days for delay in responding to the final rejection. Applicant states a response to the final rejection was filed within the three-month period.

Re Delay in Responding to Notice to File Missing Parts

As to the response to the Notice to File Missing Parts of Application, applicant's attention is directed to the OG Notice dated January 15, 2002 (1254 OG 92), in which, the Office advised applicants that:

If a reply to an Office action or notice was mailed on or after October 13, 2001 and no later than December 1, 2001 (as shown on a certificate of mailing under 37 CFR 1.8), and the applicant is otherwise entitled to patent term

adjustment (or additional patent term adjustment) but for the fact that there was a reduction of such patent term adjustment under 35 U.S.C. 154(b)(2)(C)(ii) and 37 CFR 1.704(b) due to the receipt of such reply by the Office more than three business days after the date indicated on the certificate of mailing, the Office will consider the USPS mail situation discussed in this notice to constitute a sufficient showing that, in spite of all due care, the applicant was unable to reply to the Office action or notice within three months of the date of mailing of the Office action or notice. In this situation, the Office will, subject to the conditions set forth below, reinstate a period equal to the period beginning on the date that is four business days after the date indicated on the certificate of mailing on the reply and the date of receipt (37 CFR 1.6) of the reply in the Office up to a maximum of three months.

The relevant reply to the Notice mailed August 14, 2001 was mailed on November 14, 2001, as shown by the certificate of mailing under § 1.8 thereon. However, the patent term adjustment was reduced by 61 days because the reply was not received in the Office until January 2, 2002. In addition, the Office entered the date of January 14, 2002 as the date the application was considered complete in response to the Notice and used that later date in calculating the 61 day reduction of patent term adjustment.

Thus, it is concluded that the Notice dated January 15, 2002 is applicable to this situation; in spite of all due care, the applicants were unable to reply to the Notice to File Missing Parts within three months of the date of mailing of the notice. It is further concluded that applicants have met the other conditions set forth in the Notice for reinstatement of patent term. In this instance, the period of reinstatement begins on November 20, 2001, the day that is four business days after November 14, 2001, and ends on January 2, 2002, the date of receipt of the reply. Accordingly, applicant is entitled to reinstatement of the period of reduction of 44 days. With the reinstatement, the patent term adjustment would be increased by 44 days (95 + 44) to 139 days.

Furthermore, given that in calculating the reduction, the Office should have used the date of January 2, 2002, rather than January 14, 2002, the reduction must be further corrected. A

review of the application file reveals that the response is present in the application file with a date of receipt of January 2, 2002. As the application was complete on January 2, 2002, the patent term adjustment should not have been reduced by 12 days for the period from January 3, 2002 to January 14, 2002. With this correction, the patent term adjustment would not have been reduced by 12 days, and thus, should be 151 days (229 - 122 (+ 44)).

As this reduction is not the sole basis for the application for patent term adjustment, the fee set forth in 37 CFR 1.18(e) will not be waived.

Re Delay in Responding to Final Rejection

The reduction of 66 days for delay in responding to the final rejection mailed September 16, 2003 has been reconsidered, and found to be correct. As the amendment filed December 22, 2003, was not in compliance with § 1.113(c), the period for reply to the final rejection mailed September 23, 2003, continued to run. Such an after final amendment that does not place the application in condition for allowance is not a reply within the meaning of § 1.704(b). See Advisory Action mailed January 23, 2004.

On the other hand, the amendment filed February 20, 2004, led to the issuance of a non-final rejection. In view thereof, the reply is considered a reply within the meaning of § 1.704(b). Accordingly, pursuant to § 1.704(b), the patent term adjustment was reduced by 66 days for applicant delay from December 17, 2003 to February 20, 2004.

In view thereof, the patent term adjustment at the time of the mailing of the notice of allowance is one hundred fifty-one (151) days.

Petitioner is reminded that if an application is entitled to an adjustment under 35 U.S.C. 154(b)(1)(B), the entire period during which the application (except for periods excluded under 35 U.S.C. 154(b)(1)(B)(i)-(iii)), and not just the period beginning three years after the actual filing date of the application, is the period of delay under 35 U.S.C. 154(b)(1)(B) in determining whether periods of delay overlap under 35 U.S.C. 154(b)(2)(A). Thus, any days of delay for Office issuance of the patent more than 3 years after the filing date of the

application, which overlap, with the days of patent term adjustment accorded prior to the issuance of the patent will not result in any additional patent term adjustment. See 35 U.S.C. 154(b)(1)(B), 35 U.S.C. 154(b)(2)(A), and 37 CFR § 1.703(f). See also *Revision of Patent Term Extension and Patent Term Adjustment Provisions; Final Rule*, 69 Fed. Reg. 21704 (April 22, 2004).

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

Karin Ferriter
for

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of REVISED PAIR screen